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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/616,323

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Laurence A. Cole

MBHB 03-411-A

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EXAMINER

REDDIG, PETER J

ART UNIT

PAPER NUMBER

1642

MAIL DATE

DELIVERY MODE

11/13/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/616,323

**Applicant(s)**

COLE, LAURENCE A.

**Examiner**

Peter J. Reddig

**Art Unit**

1642

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 27 August 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 29 August 2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: 12.  
Claim(s) rejected: 1, 2, 5-16, 46 and 47.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/Karen A Canella/  
Primary Examiner, Art Unit 1643

Continuation of 3. NOTE: The amendments of claims 1 and 12 to include an immunoassay which determines the selective binding of monoclonal B152 to ITA would require further search and/or consideration.

Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejection of claims 1, 5-8, 10 and 11 under 35 USC 112 2nd paragraph in section 4, page 2, claims 1, 2, 5-16, 46, and 47 under 35 USC 112 1st paragraph in section 5, pages 2-5, claims 1, 2, 6-8, 10 and 11 under 35 U.S.C. 102(b) in section 10, pages 7-8 and claims 5 and 46 under 35 U.S.C. 103(a), in the Office Action of May 29, 2008.

Continuation of 11, does NOT place the application in condition for allowance because: Claims 12 and 47 remains rejected under 35 USC 112 1st paragraph for the reasons previously set forth in the Office Action of May 29, 2008, section 6, pages 5-6.

Applicants argue that the amendment to claim 12 to the patient to be diagnosed is a patient previously diagnosed as having quiescent gestational trophoblastic disease or previously treated for an invasive gestational trophoblastic disease enables the claims.

Applicants' arguments have been carefully considered, but have not been found persuasive because the amendment has not been entered and will not be entered for the reasons set forth above, therefore the claims have not been amended and the rejections remain for the reasons previously set forth.

Claims 1, 2, 6-16 and 47 remain rejected under 35 USC 112 1st paragraph for the reasons previously set forth in the Office Action of May 29, 2008, section 7, page 6.

Applicants argue that with the amendment to the claims, practicing the invention as claimed is clearly enabled. Note that the ITA measured is that which binds to monoclonal antibody B152, the binding of which is specific for ITA and O-linked glycosyl residues (see the enclosed Birken article). The measurement of intact hCG and beta hCG is well known in the art. The measurement of ITA using monoclonal antibody B152 is enabled. It is therefore respectfully submitted that the measurement of hCG, beta hCG and ITA as claimed in the biological sample is enabled, inasmuch as measurement of hCG, beta hCG and ITA in urine, plasma or serum is relatively facile and diagnosing the conditions as claimed flows directly and readily from those measurements. Inasmuch as the measurement of each of hCG, beta hCG and ITA as claimed is enabled, practicing the remaining steps of the claimed invention to determine the existence of the condition is also enabled and facile. The method now clearly reflects the fact that the condition is detecting the presence or absence of invasive trophoblast cells in a patient, not the sample.

Applicants' arguments have been carefully considered, but have not been found persuasive because the amendment has not been entered and will not be entered for the reasons set forth above, therefore the claims have not been amended to using the monoclonal antibody B152 and the rejections remain for the reasons previously set forth.

Applicants argue that the amount of intact hCG and optionally, beta hCG as claimed may be measured using any number of methods which are available in the art and are well described in the measure hCG and beta hCG and may be preferably used. These may be used directly or adapted with minor variation in order to obtain an amount of hCG in a sample. Antibodies are readily available commercially which may measure intact hCG and ITA, and optionally, beta hCG. Regarding the measurement of ITA, the preferred method for measuring ITA in a sample is through the use of monoclonal B152, which is readily available and is claimed. Applicants argue that all of the components for practicing the invention are available and well known in the art, all of the steps are well known and practicing the method which simply relies on well known steps already known in the art using components which are readily available in the art evidences that the claimed method "is clearly enabled. Applicants argue that the presently pending claims are enabled.

Applicant's argument has been considered, but has not been found persuasive because the comprising language in the claims still encompasses measuring other forms of hCG and ITA, as contemplated in the specification no nexus has been established between the broadly contemplated hCG and ITA and detecting the presence or absence of invasive trophoblast cells in a patient or diagnosing gestational trophoblastic disease in a patient as previously set forth.

Claims 1, 2, 6-16 and 47 remain rejected under 35 USC 112 1st paragraph for the reasons previously set forth in the Office Action of May 29, 2008, section 8, pages 6-7.

Applicants argue that the present claims now adequately directed to measuring the amount hCG (intact hCG plus ITA alone or in combination with beta hCG) which is measured to provide the presently claimed method. That is now adequately described in the specification and set forth in the claims. Applicants argue that a review of the claimed subject matter and the specification clearly evidences that the present invention is now in compliance with the requirements of 35 U.S.C. § 112, first paragraph as related to the written description requirement.

Applicant's argument has been considered, but has not been found persuasive because the comprising language in the claims still encompasses measuring other forms of hCG for detecting the presence of invasive trophoblast cells or diagnosing quiescent gestational trophoblastic disease as contemplated in the specification and thus, as previously set forth the specification the claims are not adequately supported by a written description.

Claim 9 remains objected to for the reasons previously set forth in the Office Action of May 29, 2008, section 9, page 7.

Applicants argue that the amendment has obviated this objection.

Applicants' arguments have been carefully considered, but have not been found persuasive because the amendment has not been entered and will not be entered for the reasons set forth above, therefore the claims have not been amended and the objection remains for the reasons previously set forth.

Claims 12 and 47 remain rejected under 35 U.S.C. 112, second paragraph for the reasons previously set forth in the Office Action of May 29, 2008, section 12, pages 16, because Applicants have not traversed this rejection and the amendment has not been entered and will not be entered for the reasons set forth above, therefore the claims have not been amended and the rejections remain for the reasons previously set forth.

Claims 1, 2, 5-16, 46, and 47 remain rejected under 35 USC 112, first paragraph, for the reasons previously set forth in the Office Action of May 29, 2008, section 13, page 17, because Applicants have not traversed this rejection and the amendment has not been entered and will not be entered for the reasons set forth above, therefore the claims have not been amended and the rejections remain for the reasons previously set forth.

All other objections and rejections recited in the Office Action of May 29, 2008, are withdrawn in view of Applicant's arguments.